

OLIVA
Serial No. 09/497,552

Atty Dkt: 3572-15
Art Unit: 2873

REMARKS/ARGUMENTS

Reexamination of the captioned application is respectfully requested

A. SUMMARY OF THIS AMENDMENT

By the current amendment, Applicant basically:

1. Cancels claim 9 without prejudice or disclaimer.
2. Amends claims 1, 10 and 30-32.
3. Thanks the Examiner for the indication of allowable subject matter in claims 9, 10, 30 and 31.
4. Thanks the Examiner for the allowance of claims 17-21, 23-25 and 28.
5. Respectfully traverses the rejection under 35 USC §112, first paragraph.
6. Respectfully traverses all prior art rejections.

B. CLAIMS 32 - 38 DO SATISFY 35 USC §112, FIRST PARAGRAPH

Applicant respectfully traverses the rejection of claims 32-38 under 35 U.S.C. 112. The text of the application as originally filed clearly discloses the claimed subject-matter. See specifically page 9, lines 1-9, figures 5 and 6 and page 17, line 29 to page 18, line 4. This rejection should thus be withdrawn.

C. PATENTABILITY OF THE REJECTED CLAIMS

Claims 32 and 34 stand rejected under 35 USC §102(b) as being clearly anticipated by U.S. Patent 5,233,170 to Metlitsky et al. Claims 1, 2, 4-8, 11-16, 22, 26, 27, 29, 32-37, 38 and 39 stand rejected under 35 USC §102(b) as being clearly anticipated by U.S. Patent 5,717,194 to Forbes et al. Claims 1, 2, 4, 5, 11-15, 26, 29 and 32-36 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 6-14 and 17 of copending U.S. Patent Application

OLIVA
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09/773,384. All prior art rejections are respectfully traversed for at least the following reasons.

Independent claim 1 has been amended by incorporating the subject matter of allowable claim 9. Claim 9 has been canceled and claim 10 amended to be dependent on claim 1. Thus, independent claim 1 and all claims dependent thereon are deemed allowable.

Allowable claims 30 and 31 have been rewritten in independent form including all of the limitations of the base claims and any intervening claims. Accordingly, claims 30 and 31 are deemed allowable.

Applicant respectfully traverses the rejection of 32 and 34 over Metlitsky. Independent claim 32 requires that the focusing lens and the first means adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam are part of a single optical element. By contrast, in Metlitsky the focusing lens and the diaphragm are two distinct optical elements. Therefore the rejection is not accurate.

The Examiner apparently reads in the wording "*beyond an outer edge*" to cover an embodiment of Metlitsky wherein the diaphragm is downstream the front outer surface of the focusing lens. To make clear a further difference between independent claim 32 and Metlitsky, Applicant replaces the word "*beyond*" with "*around*" in independent claim 32. The diaphragm of Metlitsky, being downstream the focusing lens, is not around an outer edge of the focusing lens. Thus, Metlitsky does not teach or suggest the claimed feature that the means adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam is arranged around an outer edge of the focusing lens.

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The Examiner apparently also did not notice that claim 32 requires that the entire portion of the laser beam collected by the focusing lens is focused, while in Metlitsky only the central portion of the laser beam collected by the focusing lens is focused.

For reasons such as those provided above, the rejection of claim 32 over Metlitsky should be withdrawn.

As to the rejection over Forbes, claim 32 requires that the focusing lens and the first means adapted to separate a central portion of the laser beam from a surrounding portion of the laser beam be part of a single optical element and that this first means is arranged around an outer edge of the focusing lens. In this regard, the only embodiments of Forbes which are to be taken into consideration are those illustrated in figures 12-14, wherein the focusing lens 70, 80, 90 and the phase mask 100 are actually integral with each other. However, these embodiments do not show the claimed feature that the first means (the phase mask 100) is arranged around an outer edge of the focusing lens. Rather, Forbes discloses that the phase mask 100 is arranged on a central portion of the focusing lens 70, 80, 90. Amended claim 32 herewith enclosed is therefore novel and non obvious over Forbes and should thus be allowed.

The same considerations pointed out above with respect to claim 32 apply to claims 38 and 39, which thus should also be allowed. In addition to these consideration, claim 38 requires that the first means and the focusing lens are never adjacent along any direction of propagation of the laser beam, while in the embodiments of figures 12-14 of Forbes the phase mask 100 and the focusing lens 70, 80, 90 are adjacent at least along some directions of propagation of the laser beam, for example along the axial direction of propagation of the laser beam. Claim 38 should thus be allowed also for this last reason.

OLIVA
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Atty Dkt: 3572-15
Art Unit: 2873

Applicant traverses the provisional double patenting rejection as being premature since a patent has yet not issued with respect to copending application 09/773,384, now on appeal. Applicant reserves the right to file a Terminal Disclaimer if and when such prove necessary.

D. MISCELLANEOUS

In view of the foregoing and other considerations, all claims are deemed in condition for allowance. A formal indication of allowability is earnestly solicited.

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Should the Examiner feel that an interview with the undersigned would facilitate allowance of this application, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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